

REMARKS

Reconsideration and withdrawal of the rejections to the claims set forth in the Office Action of September 27, 2005 are respectfully requested in view of the following remarks.

Status of the claims

Claims 1-20 are pending.

Claims 1-5 and 11-15 stand rejected under 35 U.S.C. § 112.

Claims 1-20 stand rejected under 35 U.S.C. § 103.

Claim 6, 9, 10, 16, 19, and 20 have been canceled without prejudice.

Claims 1, 7, 8, 11, 17, and 18 have been amended.

None of the amendments to the claims introduces new matter.

New claims 21-24 are presented for examination.

Drawing Objections

The Examiner has objected to the drawings under 37 C.F.R. 1.83(a) as failing to show every feature of the invention specified in the claims. Applicant respectfully traverses this objection.

With regard to claims 3, 7, 13, and 17, the magnet depicted in the figures is shown as embedded.

With regard to claims 4 and 14, the recess on the second portion is depicted for example in Fig. 5, with reference identifier 34.

Reconsideration and withdrawal of this objection are respectfully requested.

Claim Rejections – 35 U.S.C. § 112

The Examiner has rejected claims 1-5 and 11-15 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Applicant has amended claims 1 and 11 to contain the limitation “attached to the second portion, one of a further magnet and a magnetic material adapted to communicate with the magnet attached to the first portion.” Accordingly, the rejection under 35 U.S.C. § 112 should be withdrawn.

Claim Rejections – 35 U.S.C. § 103

The Examiner has rejected claims 1, 5, 6, 11, 15, and 16 under 35 U.S.C. § 103 as being unpatentable over the U.S. Patent No. 5,431,317 to Kliot (“the Kliot reference”) in view of U.S. Patent No. 5,473,799 to Aoki (“the Aoki reference”). Reconsideration and withdrawal are respectfully requested based on the following remarks.

Amended claim 1 of the instant application is directed to an attachment to a carrying strap. The attachment includes (a) a first portion adapted to be *connected to the strap*, (b) second portion adjacent to the first portion, (c) *a magnet attached to the first portion*, the magnet being capable of removably securing the second portion to the first portion when the first and second portions are brought in proximity, (d) and attached to the second portion either a further magnet and a magnetic material which is adapted to communicate with the magnet attached to the first portion.

The Kliot reference is directed to a multimode traveling bag. (The Kliot reference, title). The Kliot reference teaches “attachment for straps which includes a pair of fasteners on first and second ends which may comprise hood and loop materials.” (Office Action dated Sep. 27, 2005, pg. 4). The Kliot reference fails to suggest the use of magnets. (*Id.*)

The Aoki reference is directed to a magnetic closure device. (The Aoki reference, title). The Aoki reference discloses a device that “may be used to fasten a flap on a bag, handbag, and the like, or may provide the equivalent function of a button on clothing.” (*Id.* at col. 1, lines 11-13).

The Aoki reference fails to address the problem that the inventor of the instant application was concerned with -- particularly, inventing an attachment to a carrying strap that makes carrying baggage more comfortable and convenient for a user. (The Instant Application, paragraph [0001]). The Aoki reference addresses fastening *flaps* on handbags, while the instant application concerns “an attachment to a *strap*.” The Aoki reference addressed different design, manufacturing, and usability considerations, as it dealt with magnetic fasteners which retain articles inside of handbags, while the instant application deals with design, manufacturing, and usability considerations with respect to keeping an attachment closed around a strap. Thus, the inventor in Aoki was addressing an entirely different problem that Applicant in the instant application, and the Aoki reference should not be combined with the Kliot reference under 35 U.S.C. § 103.

Moreover, there is no suggestion in the prior art represented by such references that they be combined in the manner proposed by the Examiner. Absent such a suggestion, there would be no reason why one skilled in the art, who was faced with the same problem confronting the applicant and who had no prior knowledge of Applicant's claimed structure, would consult the particular combination of references suggested by the Examiner. In any event, the structure that results from the Examiner's proposed combination of references would not meet the limitation of the “a first portion adapted to be *connected to the strap* . . . a magnet attached to the first portion” of claim 1. In view of the complete absence of this claim limitation in the Aoki reference, and

thus the fact that the Kliot and Aoki references does not disclose each and every element of either claim 1, either expressly or inherently, claim 1 is patentable over the combination of the Kliot and Aoki references. Accordingly, the rejection under 35 U.S.C. § 103(a) should be withdrawn and claim 1 should be allowed.

Independent amended claim 11 is similarly patentable over the Kliot and Aoki references.

Claim 5 depends from what is believed to be allowable claim 1, and thus the rejection to claim 5 should also be withdrawn.

Claim 15 depends from what is believed to be allowable claim 11, and thus the rejection to claim 15 should also be withdrawn.

Applicant has canceled claims 6 and 16 of the instant application without prejudice, rendering the rejection of these claims moot.

Claim Rejections – 35 U.S.C. § 103

The Examiner has rejected claims 2, 4, 9, 10, 12, 14, 19, and 20 under 35 U.S.C. § 103 as being unpatentable over the Kliot and Aoki references “as applied to claims 1 and 11,” and further in view of U.S. Patent No. 5,083,825 to Bystrom et al. (“the Bystrom reference”) or U.S. Patent No. 3,912,140 to Franges (“the Franges reference”). Reconsideration and withdrawal are respectfully requested based on the following remarks.

Applicant has canceled claims 9, 10, 19, and 20 making the rejection to these claims moot.

The Bystrom or Franges references have been cited only for the teaching of “a recess in one portion of the attachment to receive the contacting portion to provide a smooth contact area.” (Office Action dated Sep. 27, 2005, pg. 5). They do not disclose or suggest any of the aforementioned features of parent claims 1 and 11 missing from the Kliot and Aoki references,

and have not been so cited. Thus, claims 2 and 4, and claims 12 and 14, which are dependent upon claims 1 and 11 respectively, are not rendered obvious by the combination of the Kliot and Aoki references with the Bystrom or Franges reference.

Claim Rejections – 35 U.S.C. § 103

The Examiner has rejected claims 3, 7, 8, 13, 17, and 18 under 35 U.S.C. § 103 as being unpatentable over the Kliot and Aoki references “as applied to claims 1, 2, 6, 11, 12 and 16,” and further in view of U.S. Patent No. 3,051,130 to Morris (“the Morris reference”). Reconsideration and withdrawal are respectfully requested based on the following remarks.

As with the Aoki reference, the Morris reference fails to address the problem that the inventor of the instant application was concerned with -- particularly, inventing an attachment to a carrying strap that makes carrying baggage more comfortable and convenient for a user. (The Instant Application, paragraph [0001]). The Morris reference addresses “cases of the pocket-size variety which are attachable to one’s apparel,” and for fastening the *flap* thereon. (The Morris reference, col. 1, lines 10-11, and Figs. 1-6.) The instant application, however, concerns “an attachment to a *strap*.” The Morris reference addressed different design, manufacturing, and usability considerations, as it dealt with magnetic fasteners which retain items inside of pocket-size cases, while the instant application deals with design, manufacturing, and usability considerations with respect to keeping an attachment closed around a strap. Thus, the inventor in Morris was addressing an entirely different problem that Applicant in the instant application, and the Morris reference should not be combined with the Kliot reference under 35 U.S.C. § 103.

Moreover, there is no suggestion in the prior art represented by such references that they be combined in the manner proposed by the Examiner. Absent such a suggestion, there would be no reason why one skilled in the art, who was faced with the same problem confronting the

applicant and who had no prior knowledge of Applicant's claimed structure, would consult the particular combination of references suggested by the Examiner.

In addition, the Morris reference has been cited only for the teaching of an "embedded magnet between layers." (Office Action dated Sep. 27, 2005, pg. 5). The Morris reference does not disclose or suggest any of the aforementioned features of parent claims 1 and 11 missing from the Kliot and Aoki references, and has not been so cited. Thus, claims 3, 7, and 8, and claims 13, 17, and 18, which are dependent upon claims 1 and 11, respectively, are not rendered obvious by the combination of the Kliot and Aoki references with the Morris reference.

New Claims

Applicant has presented new claims 21-24 for examination.

Conclusion

In view of the foregoing, the application is now believed to be in condition for formal allowance. Prompt and favorable action is respectfully requested. A check in payment of the three-month extension fee is enclosed. Applicant does not believe that any additional fee is required in connection with the submission of this document. However, should any additional fee be required, or if any overpayment has been made, the Commissioner is hereby authorized to charge any fees, or credit or any overpayments made, to Deposit Account 02-4377.

Respectfully submitted,
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